

REMARKS

The Pending Claims

Claims 1-20 remain pending, and claims 21-24 are added by this amendment.

Claims 1, 4, 5, 11, 13-15, 18 and 19 have been amended, and claims 21-24 have been added, to describe the invention more clearly. No new matter has been added, the basis for the amended claim language may be found within the original specification, claims and drawings. Claims 1, 4, 5, 11, 18 and 19 are supported at, for example, page 1, line 6 of the first paragraph, and page 6, line 2 of the fourth full paragraph (*see also*, in the context of page 3, fourth paragraph) in the priority application PCT/EP01/15195, using the term “flächige,” which, as shown in the attached copies, is defined in various dictionaries, e.g., *Dictionary of Engineering and Technology* (5th ed., Dr.-Ing, Richard Ernst), and *Dictionary of Chemistry* (1994, Gerhard Wenske) as “sheet-like.” Claims 13-15 are amended to correct minor typographical errors.

THE OFFICE ACTION

Restriction Requirement

The Official Action mailed June 2, 2004 asserts there are 2 distinct inventions (identified as Groups I - II) claimed in the referenced application.

The Official Action asserts that the groups are independent and distinct and would require independent searches and that the searches for the inventions would not be coextensive.

The Office Action further asserts that the referenced application contains the following patentably distinct species:

(A) Porous components species (e.g., plastic membranes, metal membranes, woven fabric, non-woven fabric, etc.);

(B) Treatment material species (e.g., filtration material, absorbents, extractor material, etc.; and

(C) Introducing species (e.g., pressure gradient, shaking, packing, etc.),

and requires an election of a single disclosed porous components species, a single disclosed treatment material species, and a single disclosed introducing species.

ELECTION OF GROUP WITH AND SPECIES WITH TRAVERSE

In order to comply with the requirements of the Patent and Trademark Office, Applicants provisionally elect, *with traverse*, Group I (claims 1-11 and 17-20) drawn to a fluid treatment module. Applicants further elect, *with traverse*, porous component species non-woven fabric, treatment material species, absorbent, and, if the requirement regarding species (C) applies to the Group I claims, introducing species pressure gradient, covered in

claims 1-9, 12, 13, 16, 17, 19 and 20, and also in newly added dependent claims 21-24. It is submitted that newly added dependent claims 21-24, which depend from claims 1 or 17, should also be included with the Group I claims.

However, Applicants respectfully submit that the claims of all of the groups, and all species included therein, should be considered together in the examination of the present application.

DISCUSSION

It is respectfully submitted that the restriction is improper.

The claims of Group I relate to a fluid treatment module, and the claims of Group II relate to a method of making a fluid treatment module. Thus, any search and consideration of the claimed subject matter of Group I will likely overlap and encompass that for the claimed subject matter of Group II. Accordingly, the searches for these two groups of claims cannot in any way be said to be completely "independent." This does not mean that the claims necessarily stand or fall together, but the overlapping nature of the searches remains and mitigates against a restriction requirement.

Examination of the patent application would be most expeditious by examining all pending claims together. As Section 803 of the MPEP requires,

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct and/or independent inventions.

This rule applies to a requirement for election of species, as clarified in MPEP Section 802.02, wherein the term "restriction" includes election of species.

The restriction requirement is improper because the Examiner has not shown that a search and examination of the entire application would, indeed, cause a *serious* burden, as required by Section 803 of the MPEP for proper restriction. In fact, a serious burden would arise only if examination of the patent application were restricted to one of the claim groups. Filing additional patent applications containing the non-elected claims would unnecessarily burden (1) the Patent and Trademark Office, since it must assume the additional labor involved in examining at least two separate applications; (2) the public, since it will have to analyze at least two patents (assuming the subject matter of each claim group is found patentable) to ascertain all of the claimed subject matter; and (3) the Applicants, since the Applicants must bear the substantial financial burden and delays associated with prosecution of multiple patent applications and the payment of maintenance fees for multiple patents.

While the inventions defined by the claims may be distinct and independent, there is no demonstration that the search and examination of all the pending claims would entail a serious burden to the Examiner. In particular, it is submitted that any additional burden on

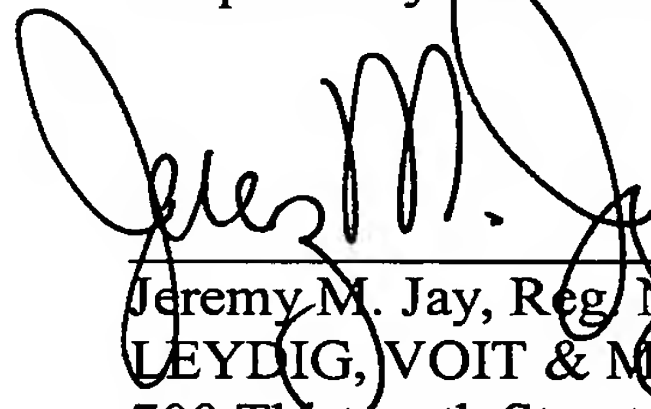
the Examiner in considering Groups I and II together is not so serious as to require restriction, and therefore, Applicants respectfully request withdrawal of the restriction requirement.

With regard to the requirement for election of species, the Office Action fails to meet the criteria under Section 803 of the MPEP, as is required for a proper election of species requirement, by not even so much as asserting there would be a serious burden on the Examiner if an election of species were not required. In addition, the Office Action failed to set forth any differences in the classification with respect to the species. In the absence of an undue burden, all of the species and claims must be examined together. In any event, Applicants understand that, consistent with an election of species requirement, other species will be considered within a generic claim encompassing the elected species upon an indication of allowable subject matter with respect to the generic claim.

For the reasons set forth above, Applicants respectfully submit there would be no "serious burden" on the Examiner to examine together all of the claims of Groups I-II, along with all species included therein.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Jeremy M. Jay, Reg. No. 33,587
LEYDIG, VOIT & MAYER
700 Thirteenth Street, N.W., Suite 300
Washington, DC 20005-3960
(202) 737-6770 (telephone)
(202) 737-6776 (facsimile)

Date:

2 July 2004